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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	94002369
Party	Applicant The Washington Trust Company
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Submission	Other Motions/Papers
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Date	06/23/2011
Attachments	Consented Motion.PDF (15 pages)(719943 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

THE WASHINGTON TRUST COMPANY,

Plaintiff,

vs.

WASHINGTON TRUST BANK,

Defendant.

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) CONCURRENT USE NO. 94002369
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Consented Request for Issuance of Concurrent Use Registrations

Plaintiff, The Washington Trust Company, together with the Defendant, Washington Trust Bank, hereby submit a copy of their Concurrent Use Agreement, attached hereto as Exhibit A.

The Parties respectfully request that the Trademark Trial and Appeal Board find the Concurrent Use Agreement acceptable and that the parties are entitled to the concurrent use registrations they seek. See Section 2(d) of the Trademark Act, 15 USC 1052(d); *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988) (agreements to be given "substantial weight"); *In re Beatrice Foods Co.*; *In re Fairway Foods, Inc.*, 166 USPQ 431, 437 (C.C.P.A. 1970) ("there can be no better assurance of the absence of any likelihood of confusion, mistake or deception than the parties' promises to avoid any activity which might lead to such likelihood.")

Plaintiff makes this request with the consent of Defendant's counsel, Mr. Mark W. Hendricksen.

Respectfully submitted,

THE WASHINGTON TRUST COMPANY

June 23, 2011

By:


Selena M. Spritz

Edward W. Gray

Counsel for Plaintiff

FITCH, EVEN, TABIN & FLANNERY

120 South LaSalle Street, Suite 1600

Chicago, Illinois 60603-3406

Phone: 312.577.7000 Fax: 312.577.7007

CERTIFICATE OF SERVICE

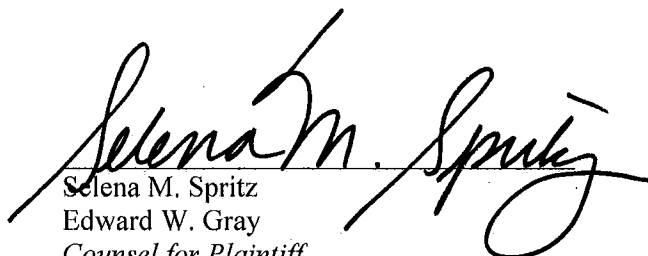
The undersigned hereby certifies that a copy of the foregoing document, **Consented Request to Issuance of Concurrent Use Registrations**, was duly served upon the Defendant by mailing a copy thereof, by First Class U.S. Mail, postage prepaid thereon and properly addressed, and by e-mail to the following attorney of record:

Mark W. Hendricksen
WELLS ST. JOHN P.S.
601 West First Avenue, Suite 1300
Spokane, WA 99201-3828
Telephone: (509) 624-4276
Facsimile: (509) 838-3424
Email: mhendricksen@wellstjohn.com

and is being filed with the USPTO via electronic transmission to:

United States Patent and Trademark Office
Trademark Trial and Appeal Board

on this 23rd day of June, 2011.

A handwritten signature in black ink, reading "Selena M. Spritz". The signature is fluid and cursive, with the first name "Selena" and last name "Spritz" clearly legible. The middle initial "M." is also present. The signature is written over a horizontal line.

Selena M. Spritz
Edward W. Gray
Counsel for Plaintiff
FITCH, EVEN, TABIN & FLANNERY
120 South LaSalle Street, Suite 1600
Chicago, Illinois 60603-3406
Phone: 312.577.7000 Fax: 312.577.7007

EXHIBIT A

CONCURRENT USE AGREEMENT

This Agreement is made as of the date of the last execution below by and between The Washington Trust Company, of Westerly ("WTC"), a Rhode Island Corporation, having an address of 23 Broad Street, Westerly, Rhode Island 02891, and Washington Trust Bank ("WTB"), a Washington Corporation, having an address of 717 West Sprague Avenue, Spokane, Washington 99210.

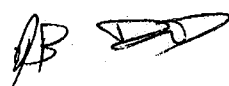
WHEREAS, WTB is the owner of the trademarks and domain names listed on the attached Exhibit A.

WHEREAS, WTC is the owner of the trademarks and domain names listed on the attached Exhibit B.

WHEREAS, WTC and WTB (collectively the "Parties"), intend hereby to settle and fully resolve all current and future differences between them, know or unknown, related to the Parties' use of the mark WASHINGTON TRUST for banking and financial services.

THEREFORE, in consideration of the mutual promises set forth herein and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the Parties hereto agree as follows:

1. WTB agrees that WTC has sole and exclusive right use the WASHINGTON TRUST mark for banking and financial related services for physical banking related locations in the States of Alabama, Connecticut, Delaware, Florida, Georgia, Illinois, Indiana, Kentucky, Maine, Maryland, Massachusetts, Michigan, Mississippi, New Hampshire, New Jersey, New York, North Carolina, Ohio, Pennsylvania, Rhode Island, South Carolina, Tennessee, Vermont, Virginia, West Virginia, and Wisconsin; and the U.S. Territories of Puerto Rico and the United States Virgin Islands ("WTC Territory").



2. WTC agrees that WTB has sole and exclusive right to use the WASHINGTON TRUST mark for banking and financial services for physical banking related locations in the States of Alaska, Arizona, Arkansas, California, Colorado, Hawaii, Idaho, Iowa, Kansas, Louisiana, Minnesota, Missouri, Montana, Nebraska, Nevada, New Mexico, North Dakota, Oklahoma, Oregon, South Dakota, Texas, Utah, Washington, and Wyoming; and the U.S. Territories of Washington, D.C., Guam and Northern Mariana Islands. ("WTB Territory").

3. The Parties agree not to intentionally use the WASHINGTON TRUST mark, in connection with banking and financial services in the other's Territory as set forth in Paragraphs 1 and 2 herein.

4. The Parties acknowledge and agree that the geographic limitations set forth herein as to their respective rights to use the WASHINGTON TRUST mark in connection with goods and services will prevent any likelihood of confusion, mistake or deception as to the source of the Parties' respective goods and services.

5. The Parties acknowledge that they currently own the domain names listed in the attached Exhibits A and B. Any additional domain names that either Party may later acquire that contain the terms WASHINGTON and TRUST shall be subject to the provisions of paragraph 13 below and adopted only upon mutual agreement. In the event the top level domains .bank or .company, or variations of those terms, become available for registering new domains, neither Party shall use a domain solely consisting of "washingtontrust" i.e. www.washingtontrust.company or www.washingtontrust.bank.

6. WTC agrees not to use anywhere WATRUST, WASHINGTON TRUST BANK, or WTB, as a trademark, trade name or in a domain name. WTB agrees not to use anywhere WTC, WASH, WASHTRUST, WASHINGTON TRUST COMPANY, WASHINGTON, WASHINGTON TRUST BANCORP, THE WASHINGTON TRUST COMPANY OF

WESTERLY, OR WASHINGTON TRUST INVESTORS as a trademark, trade name or in a domain name.

7. The Parties acknowledge that the Internet does not lend itself to geographic division, therefore the Parties agree to add a statement to the appropriate section of their respective websites that disclaims any connection with, or endorsement from the other Party, and states that the goods and/or services offered under the WASHINGTON TRUST mark are subject to the geographic limitations set forth herein. However, notwithstanding anything to the contrary herein, the Parties recognize that either may obtain or have customers within the other's Territory due to existing customer mobility and the ability of potential customers to conduct business transactions over the internet by visiting their respective internet sites.

8. The Parties recognize and accept that some limited amount of advertising or other communications utilizing "WASHINGTON TRUST," directed to their own Territory may be incidentally distributed in the other Party's Territory and not with intent to conduct business in the Territory of the other Party. The Parties believe that such incidental distribution will not have an appreciable impact on consumers, and agree to take reasonable steps to redirect any inquiries or communications that may have inadvertently been directed to the other Party to the proper Party to this Agreement. Nothing herein shall require any communication not involving a Party to this Agreement to be directed to any entity not a Party to this Agreement.

9. The Parties recognize that from time to time a banking transaction through the Federal Reserve or other third party clearing system undertaken at the behest of a customer of a Party, such as the wire transfer of funds, may necessitate the use of a Party's mark(s) within the Federal Reserve System, but outside its Territory and the Parties agree such use of a Party's mark(s) shall not be a violation of this Agreement so long as such use is sporadic and in response to specific requests by a Party's customer.



10. The Parties agree to continue to take reasonable action to eliminate or minimize any confusion due to the coexistence and registration of their respective marks, and to notify each other of any material instances of confusion in a timely fashion.

11. If the Parties are going to use the terms "WASHINGTON" and "TRUST," in an adjacent fashion, then the Parties agree to use their full trade names, "Washington Trust Bank" and "The Washington Trust Company" to the greatest extent possible in connection with offering or providing banking and financial services. Consistent with this provision, the Parties agree that the foregoing obligation does not require a Party to remove existing signage in its Territory or destroy existing promotional material.

12. Upon the U.S. Patent and Trademark Office's approval of the concurrent use arrangement reflected in this Agreement, the Parties agree to amend their respective Federal trademark registrations and/or applications identified in Exhibits A and B attached hereto, to include a concurrent use statement that reflects the understanding of this Agreement.

13. The Parties shall mutually agree upon the adoption and registration of future marks or domain names that contain the terms WASHINGTON and TRUST in an adjacent fashion prior to any use of such mark, except for those marks or domain names that incorporate the full trade name of the Parties as identified herein, for which no such prior approval will be needed. Such consent shall be given in a reasonable time period and will not be unreasonably withheld by either Party. However, WTC shall be able to adopt, register and use future marks or domain names which include "WTC" and/or "WashTrust" subject to the geographical restrictions contained herein and without prior agreement; and WTB shall be able to adopt, register and use future marks or domain names which include "WTB" and/or "WATrust" subject to the geographical restrictions contained herein and without prior agreement.

14. If consent to a future mark that contains the terms WASHINGTON and TRUST, or any abbreviations thereof, in an adjacent fashion is given as identified and provided for in Paragraph 13, the Parties agree that any Federal application or registration of said mark will contain a concurrent use statement, acceptable by the United States Patent and Trademark Office that reflects the understanding of this Agreement as to the Territory of each Party.

15. The Parties agree to execute and file with the United States Patent and Trademark Office or any other governmental office any and all documents that may be reasonably necessary or proper to effectuate the terms of this Agreement.

16. In the event that a Party should learn of any apparent infringement of the WASHINGTON TRUST mark that Party shall promptly notify the other Party of such use and agree to cooperate as needed to prevent such infringement.

17. In the event that the concurrent use registration is not issued to WTC for the WTC Territory then this Agreement shall be null and void, and not used as evidence in any further proceeding between the Parties. WTC may, but shall not be required to, make an appeal from any final refusal to issue the concurrent registration.

18. The failure of a Party to insist upon strict adherence to any term of this Agreement on any occasion shall not be considered a waiver nor deprive that party of the right thereafter to insist upon strict adherence to that term or any other term of this Agreement. Any waiver must be in writing and signed by the Party deemed to have waived a provision hereof.

19. In the event that either of the Parties ceases to use the WASHINGTON TRUST mark for a period of no less than three consecutive years or otherwise abandons the mark, the restrictions set forth in this Agreement shall no longer be enforceable and shall be deemed void.

20. This Agreement shall be considered as drafted jointly by the Parties and no uncertainty or ambiguity found in the terms hereof shall be construed for or against any Party based on an attribution of drafting to any Party.

21. The Parties agree that, should any dispute or controversy arise between them over the interpretation or application of any of the terms of this Agreement, the Parties' principals shall first attempt to resolve the dispute or controversy in prompt mediation. In the event that such mediation is unsuccessful and a claim is brought by WTC hereunder, the exclusive forum thereof shall be the Federal courts of the State of Washington. Similarly, in the event that such mediation is unsuccessful and a claim is brought by WTB hereunder, the exclusive forum thereof shall be the Federal courts of the State of Rhode Island.

22. This Agreement contains the entire understanding of the Parties with respect to the subject matter herein and no amendment or modification will be valid unless it is in writing and signed by all the parties.

23. This Agreement shall be binding upon the Parties and their successors and assigns.

24. If any provision of this Agreement is determined to be illegal, invalid, or otherwise unenforceable by a court of competent jurisdiction, then to the extent necessary to make such provision and/or this Agreement legal, valid, or otherwise enforceable, such provision shall be limited, construed, or severed and deleted from this Agreement, and the remaining portion of such provision and the remaining other provisions hereof shall survive, remain in full force and effect, and continue to be binding, and shall be interpreted to give effect to the intention of the Parties insofar as that effect is possible.

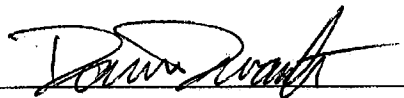
25. The Recitals set forth above are fully incorporated as binding terms of this Agreement.

Two handwritten signatures are present at the bottom right of the page. The first signature is a stylized 'B' with a horizontal line through it. The second signature is a more complex, cursive-style mark.

26. This Agreement may be executed in counterparts, each of which shall be deemed to be an original, but which together shall be deemed to constitute a single document.

IN WITNESS WHEREOF, the parties have executed this Agreement as of the dates written below.

The Washington Trust Company

By: 
Name: David V. Derault
Title: Senior E.V.P. & C.F.O.
Date: May 10, 2011

Washington Trust Bank

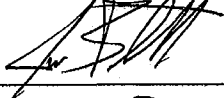
By: 
Name: Jim Brockett
Title: SVP/CIO
Date: May 6, 2011

EXHIBIT A

Washington Trust Bank's Trademarks and Domain Names

MARK	CLASS/ GOODS & SERVICES	SERIAL NO./ TM REG. NO.	REGION OF PROTECTION /REG./ PENDING	REG. DATE
WASHINGTON TRUST	036	2,248,655	United States Registered	06/01/99
WTB	036	3,394,548	United States Registered	3/11/08
WTB MONEYCARD	036	3,781,572	United States Registered	4/27/10
WTB CREDIT TRACKER	036	85/123,402	United States Pending	
WTB ELECTRONIC FILE DEPOSIT	036	85/123,404	United States Pending	
WASHINGTON TRUST BANK	036	85294028	United States Pending	
WASHINGTON TRUST FINANCIAL CORPORATION	Banking and Financial Services		Common Law	
WASHINGTON TRUST BANK WEALTH MANAGEMENT & ADVISORY SERVICES	036	85294551	United States Pending	
WASHINGTON TRUST	036	15706	Idaho Registered	06/06/97
WASHINGTON TRUST INVESTMENT SERVICES	Banking and Financial Services		Common Law	
WASHINGTON TRUST HOME LOAN CENTER	Banking and Financial Services		Common Law	

EXHIBIT A (Cont.)
WASHINGTON TRUST BANK URL'S

watrust.com
<u>www.watrust.com</u>
webmail.watrust.com
trustmail.watrust.com
info.watrust.com
lockbox.watrust.com
loans.watrust.com
<u>ftp.watrust.com</u>
flonline.watrust.com
edeposit.watrust.com
vcimaging.watrust.com
video.watrust.com
xfer.watrust.com
washingtontrustbank.com
watrust.mobi
emailwatrust.com
watrustonline.com
wtb.ebanking-services.com
(<u>https://wtb.ebanking-services.com</u>)
wtbonline.com
wtbonline.mobi
watrust.biz
wtbonline.biz
washingtontrustbank.biz
washingtontrustbank.mobi
wtbinfo.com
watrustonline.mobi
watrust.tel
forms.watrust.com
positivepay.watrust.com
mailsafe.watrust.com
washingtontrustbank.com
positivepaysand.watrust.com
Washingtontrustonline.com
washingtontrustonlinebank.com
Washingtontrustloans.com
WashingtonTrustBankloans.com
WashingtonTrustBankonlineaccounts.com
WashingtonTrustBankonlineaccountopening.com
WashingtonTrustBankonlineaccountopen.com
WashingtonTrustprivatebank.com
Washingtontrustprivatebanking.com
WashingtonTrustcommercialbank.com
WashingtonTrustcommercialbanking.com
washingtontrustwealthmanagement.com
washingtontrustwealthmanagementadvisoryservices.com
washingtontrustwmas.com

EXHIBIT B

The Washington Trust Company's Trademarks and Domain Names

Mark	Region of Protection	Appln./Reg. No.	Goods and Services
THE WASHINGTON TRUST COMPANY	Connecticut	21990	Int. Class 036: Financial services, namely retail and commercial banking, trust and investment services.
THE WASHINGTON TRUST COMPANY	Rhode Island	031211	Int. Class 036: Financial services, namely retail and commercial banking, financial planning, investment advice.
THE WASHINGTON TRUST COMPANY	United States	85/225,939	Int. Class 036: Banking and financing services; Financial services, namely, wealth management services
WASHINGTON	United States	85/225,945	Int. Class 036: Banking and financing services; Financial services, namely, wealth management services
WASHINGTON TRUST	Connecticut	21953	Int. Class 036: Financial services, namely retail and commercial banking, trust and investment services.
WASHINGTON TRUST	Rhode Island	031210	Int. Class 036: Financial services, namely retail and commercial banking, financial planning, investment advice.
WASHINGTON TRUST	United States	78/579,574	Int. Class 036: Banking and financial services, namely, banking, investment management, investment banking, international banking, corporate financing, mortgage loan, lease financing, financial planning, retirement and estate planning, investment portfolio analysis and advisory, securities brokerage, trust services, namely, investment and trust company services

EXHIBIT B (Cont.)

The Washington Trust Company's Trademarks and Domain Names

Mark	Region of Protection	Appln./Reg. No	Goods and Services
WASHINGTON TRUST	United States	85/225,936	Int. Class 036: Banking and financing services; Financial services, namely, wealth management services
WASHINGTON TRUST BANCORP, INC.	Connecticut	21943	Int. Class 036: Financial services, namely retail and commercial banking, trust and investment services.
WASHINGTON TRUST BANCORP, INC.	Massachusetts	63786	Int. Class 036: Financial services, namely retail and commercial banking, trust and investment services.
WASHINGTON TRUST BANCORP, INC.	Rhode Island	031212	Int. Class 036: Financial services, namely retail and commercial banking, financial planning, investment advice.
WASHINGTON TRUST INVESTORS	United States	78/731,770	Int. Class 036: Banking and financial services, namely, banking, investment management, investment banking, international banking, corporate financing, mortgage loan, lease financing, financial planning, retirement and estate planning, investment portfolio analysis and advisory, securities brokerage, trust services, namely, investment and trust company services
WTC	Common Law	N/A	Banking and Financial Services
WASH	Common Law	N/A	Banking and Financial Services
THE WASHINGTON TRUST COMPANY, OF WESTERLY	Common Law	N/A	Banking and Financial Services
WASHINGTON TRUST HOME LOAN CENTER	Common Law	N/A	Banking and Financial Services

EXHIBIT B (Cont.)

The Washington Trust Company's Trademarks and Domain Names

Domain Names
<u>www.washtrust.com;</u> <u>www.washingtontrust.com;</u> <u>www.washingtontrust2.com;</u> <u>www.washingtontrustcompany.com;</u> <u>www.washtrustdirect.com;</u> <u>www.washingtontrustdirect.com;</u> and <u>www.washingtontrustbancorp.com</u>

